

## **REMARKS**

### **I. Status of the Claims**

Claims 1-4, 8, and 11-13 are pending. By this Amendment, claim 1 has been amended.

### **II. Claim Rejection Under 35 U.S.C. § 101**

In the Office Action, claims 1-4, 11, and 12 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In particular, it was asserted that independent claim 1 (1) is not tied to a particular apparatus or machine and (2) does not transform the underlying subject matter into a different state or thing.

By this Amendment, claim 1 has been amended to recite a “processing device,” which comprises physical computer hardware to execute software components, as suggested in the Office Action. Thus, Applicants respectfully submit that the rejection has been overcome and should be withdrawn.

### **III. Claim Rejections Under 35 U.S.C. § 103**

In the Office Action, claims 1-4, 8, and 11-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,157,945 to Balma et al. in view of U.S. Patent No. 7,124,087 to Rodriguez et al. As explained below, this rejection should be withdrawn.

#### **Claims 1-4, 8, and 11-13 are patentable over Balma in view of Rodriguez**

Because Balma and Rodriguez fail to teach or suggest Applicant’s claimed combination recited in independent claims 1 and 8, Applicants respectfully submit that a prima facie case of obviousness has not been established and that the rejection should be withdrawn.

Balma teaches a “method and system for routing or forwarding communications to an intended recipient.” Balma at Abstract.

Balma fails to teach or suggest the “corporation’s preference” and providing to the user the “updated scheduled location and the merged preference set to facilitate delivery of the message to the recipient at the updated scheduled location” recited in independent claims 1 and 8.

It was asserted in the Office Action at page 5 that Balma teaches a “corporation’s preference.” Applicants respectfully disagree and point out the res judicata effect of the Board of Patent Appeals and Interferences decision (Appeal 2007-2438) dated December 20, 2007, in this application.

In that decision, the Board stated that “we find no support in the portion of Balma (col. 4, ll. 37-61) cited by the Examiner to support the Examiner’s conclusion that the ‘default conversion’ described by Balma can be equated to the claimed ‘corporate preferences.’” Decision at page 4. The Board further stated that “we find nothing in the cited portion of Balma, or elsewhere in Balma, which discloses the overriding of a user’s delivery preferences by corporate rules or preferences.” Id. at page 5. Finally, with regard to Fig. 6 of Balma, the Board stated that “there is no indication that such preferences are considered to be corporate preferences within the context of Balma’s disclosure.” Id.

According to M.P.E.P. § 706.07(h) (XI), under the principles of res judicata, a “Board decision in an application is the ‘law of the case,’ and is thus controlling in that application and any subsequent, related application.” Thus, the “law of the case” in this application is that Balma fails to teach a “corporation’s preference,” as claimed.

Accordingly, Applicants respectfully submit that the Examiner is precluded from making an argument to the contrary.

Rodriguez teaches a travel agent that “can maintain a travel profile for users to perform actions that the user wishes to execute while the user is away from the office.” Rodriguez at col. 2, lines 46-48. In the system of Rodriguez, the “actions can be bundled into a travel package that is transmitted to the user in response to the user making travel arrangements.” Id. at lines 49-51. Further, “[o]nce the actions are combined into a travel package, they are transmitted for processing.” Id. at lines 56-57. Finally, as identified in the Office Action at page 8, “[o]nce the actions are accepted, various processes take place depending upon the action and the user's preferences.” Id. at lines 61-62.

However, Rodriguez fails to overcome the deficiencies of Balma discussed above. For example, Rodriguez is completely silent as to the claimed “corporation’s preference.” Further, there is no teaching or suggestion in Rodriguez of providing to the user the “updated scheduled location and the merged preference set to facilitate delivery of the message to the recipient at the updated scheduled location” recited in independent claims 1 and 8.

In particular, Rodriguez provides no teaching or suggestion of merging preference sets. Thus, Rodriguez necessarily fail to teach or suggest providing to the user the “updated scheduled location and the merged preference set to facilitate delivery of the message to the recipient at the updated scheduled location,” as claimed.

Because the combined teachings of Balma and Rodriguez fail to teach or suggest Applicants’ claimed combination recited in independent claims 1 and 8,

Applicants respectfully submit that a prima facie case of obviousness has not been established and that the rejection should be withdrawn.

Applicants respectfully submit that independent claims 1 and 8 are patentable over the references applied in the Office Action. Claims 2-4 and 11-13 depend directly or indirectly from claims 1 and 8 and therefore should be allowable for at least the same reasons the claims from which they depend are allowable.

#### IV. Conclusion

Applicants respectfully request that the Examiner reconsider this application, withdraw the claim rejections, and allow the pending claims in a timely manner.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 16-1885.

Respectfully submitted,

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